



Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9341-11

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]
on April 23, 2007

Signature

Typed or printed name Sheena Donnelly

Application Number

10/519,278

Filed

12/22/2004

First Named Inventor

Marcel Wong

Art Unit

2617

Examiner

Brandon Miller

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. 42,011
Registration number _____

Signature

D. Scott Moore

Typed or printed name

919-854-1400

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

April 23, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



**RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE--EXAMINING GROUP 2617**

Attorney Docket No. 9342-11

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Wong et al.

Application Serial No.: 10/519,278

Filing Date: December 22, 2004

For: **AUTOMATED SENDING OF PRECONFIGURED MESSAGES**

Confirmation No. 8905

Group Art Unit: 2617

Examiner: Brandon J. Miller

Date: April 23, 2007

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which have been extended indefinitely

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicant requests that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 50-0220.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed January 23, 2007 (hereinafter "Final Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Applicants respectfully submit that the rejection of the currently pending claims is clearly erroneous because many of the recitations of the pending claims are not met by the cited references for at least the reasons discussed herein. Therefore, Applicants respectfully request review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will only discuss the recitations of independent Claims 1, 12, and 24.

Claims 1, 12, and 24 are Patentable

Independent Claims 1, 12, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Application Publication 2001/00216649 to Kinnunen et al. (hereinafter "Kinnunen") in view of U. S. Patent No. 6,040,275 to Boltz et al. (hereinafter "Boltz"). (Office Action, page 2). Independent Claim 1 is directed to a method of automatically sending electronic messages from a portable communication device to a selected recipient and recites, in part:

retrieving date information from an electronic date determination unit;
retrieving first recipient related information from an electronic contact register, the first recipient related information being personal date information associated with the recipient; and
automatically sending a pre-configured electronic message over a network to the recipient based on the date information and the first recipient related information. (Emphasis added).

Independent Claims 12 and 24 include similar recitations. According to the independent claims, personal date information is associated with a recipient. A pre-configured electronic message is automatically sent over a network based on date information retrieved from an electronic date determination unit and the personal date information associated with the recipient. Some embodiments of the present invention may allow more simplified sending of personal messages, such as birthday greetings, to specific recipients. For example, in the case

of a birthday greeting, device user may include birthday information along with other contact information for one or more individuals in a contact register of a portable communication device. The user may also prepare a message to wish a particular individual a happy birthday. Once the communication device determines that there is a match between the current date and the birthday of the particular individual whose contact information is in the contact register, the communication device automatically sends the already prepared birthday message to the particular individual on his/her birthday.

In sharp contrast, neither Kinnunen nor Boltz disclose or suggest, at least, associating personal date information with a recipient and storing the personal date information in a contact register and also sending a pre-configured electronic message to the recipient based on the personal date information and date information retrieved from an electronic date determination unit. Kinnunen describes a system in which a date may be associated with a message and then a recipient is restricted from opening the message until that date. While Kinnunen does describe in paragraph 19 that potential message recipients may be stored in a contact list in a radio telephone, the date on which a message can be read or opened is not stored as part of the contact list information. Instead, Kinnunen explains that "[t]he sender is further given the opportunity to set the conditions under which the multimedia message can be read by a recipient. Thus, the sender may specify the time, date and even location at which the message may be read." (Kinnunen, paragraph 19). According to the teachings of Kinnunen, a message may be sent to a recipient, but the message may include limitations on when the recipient can open or read the message. According to the recitations of independent Claims 1, 12, and 24, the date information from the electronic date determination unit along with the personal date information associated with the recipient are used as bases for sending an electronic message.

Turning next to Boltz, this reference describes a system in which a user, i.e., message sender, can define a date and time that an SMS message is to be delivered (Boltz, col. 4, lines 20 - 24; col. 4, lines 44 - 62; and col. 4, line 63 - col. 5, line 12). Boltz does not disclose or suggest associating personal date information with a recipient and storing the personal date information in a contact register. While Boltz does describe automatically sending an electronic message at a time defined by a user/sender, Boltz does not describe sending the electronic message based on personal date information associated with the recipient.

Applicants further submit that one skilled in the art would not be motivated to combine the teachings of Kinnunen and Boltz. As discussed above, Kinnunen's system is designed to prevent a recipient from opening or reading a message that is sent to him/her until a certain event, e.g., time, date, travel to a particular geographical location, has occurred. Boltz, on the other hand, is directed to a system in which a user/sender can define when a message is to be sent to a recipient. Applicants submit that the ability to prevent a user from opening or reading a message until reaching a defined time/date as taught in Kinnunen would obviate the need to delay sending the message as taught in Boltz. Applicants submit, therefore, that the combination of Kinnunen and Boltz is improper under 35 U.S.C. §103(a).

Accordingly, for at least the foregoing reasons, Applicants respectfully request that the present application be reviewed and that the rejection of independent Claims 1, 12, and 24 be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



D. Scott Moore
Registration No. 42,011

USPTO Customer No. 54414
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 23, 2007.


Sheena Donnelly